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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,154	03/01/2005	Hiromi Wataya	P26700	6656
7055 7590 03/25/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER HAUTH, GALEN H				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
03/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

# Office Action Summary

**Application No.**

10/526,154

**Applicant(s)**

WATAYA, HIROMI

**Examiner**

GALEN HAUTH

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/16/2009 has been entered.

### ***Response to Amendment***

2. Acknowledgment is made to applicant's amendment of claims 1, 3, and 12. No new matter has been added. The objection of claim 12 has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

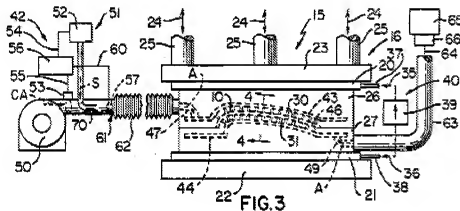
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 3, 4, 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (PN 4462785).

a. With regards to claim 3, Smith teaches an apparatus comprising upper and lower molds (26, 27) with a plurality of hot air vents (46) extending through the molds at regular intervals and a connected hot air generator (60) and vacuum (65) to circulate the hot air through the mold as seen in the figure below.



b. Smith teaches that the molds are metal (claim 7). While Smith does not explicitly teach that the plurality of hot air vents have varying lengths, Smith does teach a contoured platen surface as seen in the figure above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use varying lengths of air vents as opposed to varying heights of a main air channel as such is an obvious design choice without imparting a difference in function to the apparatus. The limitation "apparatus for making pallets" is not considered a limitation of significance because the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the

preamble merely states the purpose or intended use of the invention. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *PitneyBowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473,478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). The limitation "to provide a pallet with recesses formed on its surface" in line 6 of claim 3 does not impart patentability to the claims because it provides the intended operation of the apparatus. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

c. With regards to claim 8, Smith does not teach that the diameter of the through holes is 1 centimeter; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the diameter of the through holes to optimize the process by controlling the volume and

velocity of air through the work piece through hole diameter including 1 centimeter.

d. With regards to claim 10, Smith does not teach that there is one aperture per 5 square centimeters; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the spacing of the apertures to optimize the process by controlling the volume and velocity of air through the work piece through the density of hole outlets including one per 5 square centimeters.

e. With regards to claims 4 and 12, as seen in the figure above, the hot air vent (43, 44) extends into the circumference of the mold.

6. Claims 1-2, 5-7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wataya (JP 06-270938 A, Machine Translation of Record Used for Citation) in view of Smith (PN 4462785).

a. With regards to claim 1, Wataya teaches a method for forming a pallet from vegetable fibers comprising a non-woven fabric of fibers that are impregnated with resin to provide a sheet like base material (¶ 0006) and pressing it in a metal mold (¶ 0009). Wataya does not teach that the mold includes a plurality of hot air vents, and passing hot air through the vents.

b. Smith teaches a method for molding a fibrous work piece of fibers and a dispersed adhesive by placing the work piece between two platen and passing hot air through the work piece while pressing (abstract). Smith teaches that the fibers may be natural fibers (col 3 ln 28). Smith teaches that the air is passed

through a plurality of apertures on the surface of the platens (col 2 ln 3-14) that are dispersed over the entire confronting surface in a regular interval as seen in the figure below.

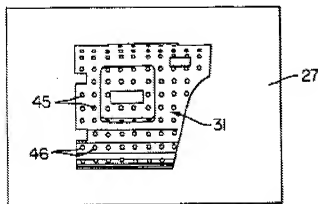


FIG. 5

c. While Wataya in view of Smith does not teach that the plurality of air vents have varying length, Wataya teaches forming a contoured pallet as seen in the figure below, and Smith teaches using a contoured platen as seen in the figure in the rejection of claim 3 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use varying lengths of air vents as opposed to varying heights of a main air channel as such is an obvious design choice without imparting a difference in function to the method.



d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the pallet of Wataya with the method of Smith, because both teach press forming resin impregnated fiber products and the method of Smith results in a highly efficient forming of a complete pad with great strength and structural integrity in a shorter cycle time (col 6 ln 55-65). While Wataya in view of Smith does not explicitly state that the airflow causes recesses formed by the air, the process of Wataya in view of Smith would inherently produce recesses given similar work pieces and molding operations as the applicant.

**NOTE:** Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. **Whether the rejection is based on "inherency" under 35 USC § 102, on prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products."** In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

e. With regards to claims 2 and 5, Wataya teaches forming the fiber from coconuts (¶ 0012).

f. With regards to claim 6, Wataya teaches that the plant fibers may be hempen vegetable fiber raw material (¶ 0012). Merriam-Webster's Dictionary defines hemp as "a fiber (as jute) from a plant other than the true hemp; also: a plant yielding such fiber." Therefore, hempen vegetable fiber raw material includes fibers from a jute plant.



- g. With regards to claim 7, Smith does not teach that the diameter of the through holes is 1 centimeter; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the diameter of the through holes to optimize the process by controlling the volume and velocity of air through the work piece through hole diameter including 1 centimeter.
- h. With regards to claim 9, Smith does not teach that there is one aperture per 5 square centimeters; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the spacing of the apertures to optimize the process by controlling the volume and velocity of air through the work piece through the density of hole outlets including one per 5 square centimeters.
- i. With regards to claim 11, as seen in the figure above in the rejection of claim 3, the hot air vent (43, 44) of Smith extends into the circumference of the mold.

***Response to Arguments***

- 7. Applicant's arguments filed 03/16/2009 have been fully considered but they are not persuasive.
  - a. With regards to applicant's arguments that Smith fails to disclose hot air blowing from one mold to the other, Smith teaches hot air blowing from one mold to the other in Fig. 4 with air flow represented by lines A as described in col 4 In 27-37.

b. With regards to applicant's arguments that Smith fails to disclose hot air vents provided on a circumference of the upper and lower molds, this argument is not persuasive. With the broadest reasonable interpretation, the air vent itself includes elements 43 and 44 in the figure used in the rejection of claim 3 which extend into a circumference of the mold. In addition, the limitation of a circumference can be used to define a circumference of a mold element such as seen in Fig. 5 and 6 of Smith in which the vents 45 and 46 extend across the circumference of a raised mold portion.

#### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GALEN HAUTH whose telephone number is (571)270-5516. The examiner can normally be reached on Monday to Thursday 8:30am-5:00pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571)272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GHH/

/Christina Johnson/  
Supervisory Patent Examiner, Art Unit 1791